

Application No. 10/721,358
Docket No.: 1020/0132PUS1

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested. Claims 1-9 and 21-28 are pending in the above application, of which claims 1, 21 and 27 are independent. By the above amendment, claims 10-20 have been cancelled without prejudice, and claims 21-28 have been added.

The Office Action dated August 14, 2008, has been received and carefully reviewed. In that Office Action, claims 1, 4-9 and 17 were rejected under 35 U.S.C. 102(e) as being anticipated by Zysnarski, claims 1-3, 6-9, 11-14 and 17-19 were rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa, and claims 2, 3, and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zysnarski. Claims 4, 5, 15 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa, and claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa in view of Snider. In addition, objections were raised in connection with the claims, and a restriction requirement was maintained in connection with two dependent claims. Each of these issues is addressed below, and reconsideration and allowance of claims 1-9 and 21-26 are respectfully requested in view of the above amendments and the following remarks.

CLAIM OBJECTIONS

Claims 1, 4-9 and 17 are objected to on the basis that "adapted to," "designed to," and "able to" perform a function are not positive limitations. The examiner cites *In re Hutchinson*, 69 U.S.P.Q. 138 (CCPA 1946), for this proposition. It is respectfully submitted that the only limitation opined on by the CCPA in the *Hutchinson* case was the phrase "adapted for use in making," which phrase is not present in any of the pending claims. The

Application No. 10/721,358
Docket No.: 1020/0132PUS1

holding of the Hutchinson case is therefore irrelevant to the present fact situation.

Hutchinson includes as dicta the statement that functional limitations may or may not be regarded as limiting. This dicta in no way establishes whether the quoted phrases are limiting in the present case. It is respectfully submitted that the examiner has provided no explanation to support a finding that the phrases are not limiting in the present case, and that a mere statement that the phrases "may not be" limiting is not a basis for objecting to the claims.

Moreover, these same phrases have been addressed by the Federal Circuit much more recently than the 1946 case relied upon by the examiner. In *In Hoffer v. Microsoft Corp.*, 74 U.S.P.Q. 2d 1481, 1483 (Fed. Cir. 2005), discussed in MPEP 2111.04, it was indicated that "The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case (emphasis added)." However, the "specific facts of the case" are not discussed in the present record. In other words, there is no absolute rule against using these phrases in a claim that would justify the present, unsupported, rejection. Unless the examiner provides some evidence or argument to show why the language objected to is improper, it is respectfully submitted that the claims are not objectionable, and the withdrawal of the claim objections is respectfully requested.

The objection also seems to object to the phrase "light rotor are formed" which is present in amended claim 1. However, this limitation does not recite a manner of making the light rotor, which might be improper. A hypothetical claim directed to a light rotor formed "by using a molding machine," for example, might not significantly limit a claim. The limitation now present in claim 1, however, "formed as a single piece," recites structure, not a method of manufacture, and is submitted to be proper.

Application No. 10/721,358
Docket No.: 1020/0132PUS1

RESTRICTION REQUIREMENT

The Office Action maintains a restriction requirement between independent claim 1 and its dependent claim 21 (claim 20 was cancelled by the above amendment and is not addressed herein). Dependent claim 21 includes every limitation of claim 1 from which it depends. It is therefore incomprehensible how these two claims could be classified differently or require different fields of search. In other words, all limitations of claim 1 must be considered in any search of claim 21; they can not be searched when examining claim 1 and then ignored when examining claim 21. In any event, the examiner has not satisfied the requirements of MPEP 802.01 to show that the inventions are independent and distinct or the requirements of MPEP 808.02 to establish a serious search burden even if the inventions were somehow shown to be independent and distinct. A prima facie basis for requiring restriction has not been presented, and the withdrawal of the restriction requirement is respectfully requested.

If the restriction requirement is not withdrawn, it is respectfully requested that the examiner respond to the above traversal (as required by MPEP 707.07(f)) and explain 1) how the requirements of MPEP 802.01 and 808.02 have been satisfied or 2) provide some legal authority for requiring restriction without satisfying the requirements of the MPEP.

REJECTION UNDER 35 U.S.C. 102(e) BASED ON ZYSNARSKI

Claim 1 was rejected under 35 U.S.C. 102(e) as being anticipated by Zysnarski. By the above amendment, the limitations of claim 10 have been added to claim 1, and claim 10 has been cancelled. Claim 10 was not rejected under 35 U.S.C. 102(e) based on

Application No. 10/721,358
Docket No.: 1020/0132PUS1

Zysnarski, and the withdrawal of the rejection of claim 1 as being anticipated by Zysnarski is respectfully requested.

REJECTION UNDER 35 U.S.C. 103(a)

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Zysnarski. The examiner acknowledges that Zysnarski does not show an optical light guide and a light rotor formed of a single piece, but argues that it would have been obvious to modify Zysnarski to make Zysnarski's light rotor and light guide as a single piece. In other words, the examiner is proposing that Zysnarski's light guide 16 and knob 14 (which includes surface 58) be formed of a single piece. However, light guide 16 is attached to panel 24. Connecting knob 14 to panel 24 would therefore prevent knob 14 from rotating. The change being proposed by the examiner would render Zysnarski's invention unsatisfactory for its intended purpose and/or change the principle of operation of Zysnarski's device. However, a modification that renders a device unsatisfactory for its intended purpose or changes that principle of operation of a device is never obvious. MPEP 2143.01. For these reasons, it is respectfully submitted that claim 1 patentably distinguishes over the art of record, and the allowance of claim 1 is respectfully requested.

It is noted that claim 1 as amended is identical in scope to prior claim 10. Therefore, if a new rejection is raised in connection with this essentially unamended claim, it is respectfully submitted that the rejection must be made in a non-final Office Action.

Claim 10 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Zysnarski in view of Snider. The examiner relies on Snider to show that Zysnarski's knob 14 and light guide 16 should be formed of a single piece. However, as discussed above,

Application No. 10/721,358
Docket No.: 1020/0132PUS1

the proposed modification will render Zysnarski unsatisfactory for its intended purpose and/or change the principle of operation of Zysnarski. The modification is therefore not obvious, regardless of the art relied upon. Claim 10 is submitted to be allowable over Zysnarski in view of Snider for at least this reason.

REJECTIONS UNDER 35 U.S.C. 103(a) BASED ON HASEGAWA

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa. Claim 10 was not rejected as being anticipated by Hasegawa. By the above amendment, the limitations of claim 10 have been added to claim 1. Claim 1 as amended is therefore submitted to be allowable over Hasegawa.

Claims 11-20 have been cancelled, thereby obviating the rejections of these claims.

NEW CLAIMS

New independent claim 21 and its dependent its claims 22-26 are also submitted to be allowable over the art of record. Claim 21 recites a control element that includes, inter alia, a rotary knob having an axis of rotation, a region of maximum width, and a sidewall, and an integral optical light guide comprising a cylindrical inner wall and an annular outer member surrounding the cylindrical inner wall and spaced therefrom by an annular slot, the cylindrical inner wall extending into a space defined by the panel portion opening and the region of maximum width, and the annular outer member underlying the scale.

In Zysnarski, the region of maximum width of knob 14 is greater than the diameter of the opening in panel 24. In addition, Zysnarski's light guide 16 does not have a cylindrical inner wall and an outer member surrounding the cylindrical inner wall and

Application No. 10/721,358
Docket No.: 1020/0132PUS1

spaced therefrom by an annular gap. Furthermore, surface 58 of Zysnarski, alleged to correspond to a "light rotor," does not comprise a light guiding rotor that conducts light from a light source to the optical light guide as recited in claim 21. Claim 21 is submitted to patentably distinguish over Zysnarski for at least these reasons.

Claim 21 is also submitted to patentably distinguish over Hasegawa. Hasegawa has a knob 2 with a region of maximum width having a width greater than the width of the opening in panel 23. In addition, neither light guide 4 nor light guide 6 includes a cylindrical inner wall member and an annular outer member surrounding the cylindrical inner wall and spaced therefrom by an annular gap or a cylindrical inner wall extending into a space defined by the panel opening and the region of maximum width of the rotary knob. Claim 21 is submitted to patentably distinguish over Hasegawa for at least these reasons.

Claims 22-26 depend from claim 21 and are submitted to be allowable for at least the same reasons as claim 21.

Claim 22 recites that the light guiding rotor extends into but not through the optical light guide. In Zysnarski, the "rotor" 58 does not extend into the optical light guide 16. Hasegawa also does not disclose a light-guiding rotor as claimed. Claim 22 is submitted to further distinguish over the art of record for these reasons.

Claim 23 further distinguishes over Zysnarski and Hasegawa by reciting that the knob region of maximum width is less than the inner diameter of the cylindrical inner wall. This limitation is not shown or suggested by Zysnarski or Hasegawa.

Claim 26 recites that the region of maximum width extends into the panel opening. This limitation is not shown or suggested by Zysnarski or Hasegawa, and claim 26 further

Application No. 10/721,358
Docket No.: 1020/0132PUS1

distinguishes over these references for this reason.

New independent claim 27 is also submitted to distinguish over the art of record. Claim 27 recites a control element including, inter alia, an integrally formed first optical light guide having first and second parts separated by an annular slot, the slot being configured to receive a part of the panel, a light source and a rotatable second light guide that transmits light from the light source into the first optical light guide. One skilled in the art would not refer to Zysnarski's element 58 as a "light guide," and Zysnarski does not show first and second light guides as recited in claim 27. The examiner has referred to element 2 of Hasegawa as a "light rotor," but this element is not a light guide, much less a light guide that transmits light from a light source into another optical light guide. Claim 27 is submitted to be allowable over Zysnarski and Hasegawa for at these reasons.

Claim 28 depends from claim 27 and is submitted to be allowable for at least the same reasons as claim 27.

CONCLUSION

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Martin R. Geissler, Applicants' Attorney at 1.703.621.7140 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future

Application No. 10/721,358
Docket No.: 1020/0132PUS1

replies, to charge payment or credit any overpayment to Deposit Account No. 50-3828 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,



Martin R. Geissler
Registration No. 51011

PO BOX 1364
Fairfax, VA 22038-1364
1.703.621.7140

Date: November 14, 2008